

REMARKS/ARGUMENTSStatus of the Claims

In the Office Action mailed January 11, 2007, claims 1-34 are pending. Claims 1-34 were rejected. The rejection is respectfully traversed. Claims 1-32 and 34 have been amended. Claim 33 has been cancelled. No new matter has been added. Applicants have thoroughly reviewed the outstanding Office Action including the Examiner's remarks and the references cited therein.

The following remarks are believed to be fully responsive to the Office Action. All the pending claims at issue are believed to be patentable over the cited references. Reconsideration and withdrawal of the outstanding rejections are respectfully requested in view of the following remarks.

Claim Rejections 35 U.S.C. §103(a)

Claims 1-34 have been rejected under 35 U.S.C. § 103(a) as being obvious. The rejections are respectfully traversed.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. M.P.E.P. § 2142. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation to modify the references or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art must teach all the claim limitations. M.P.E.P. § 2142. In light of the following arguments, the combined references do not teach or suggest all of the claim limitations of the present invention. Applicants respectfully point to the final prong of the test which states that the prior art must teach all of the claim limitations. At the very least, the combined references do not teach or suggest all of the limitations of these claims, as stated below.

**Rejection over Ennio**

Claims 1, 5-11, 16-18, and 29-34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ennio (French Patent No. 2,798,267).

Ennio does not teach or suggest, at least, a "receptacle having an inner wall, said rod and said brush being spaced from said inner wall in said assembled condition," as recited in claim 1. Rather, Ennio is directed to an applicator where the angle of the brush relative to the longitudinal axis of the rod permits excess substance to be removed from the brush by scraping the brush along an inside wall of the receptacle. (See Figure 1.) The Examiner states that, "Ennio discloses it is known in the art to form a mascara applicator with the bristle portion making an angle with respect to the longitudinal axis of the rod so that the bristles engage the inner wall of the container as the applicator is withdrawn." (Office Action p. 3.) (Emphasis supplied.)

Alternatively, in order to scrape off excess mascara, Ennio discloses a scraping mechanism near the neck of the receptacle. When incorporating such a mechanism, the angle between the brush and the longitudinal axis of the applicator is zero. (See Figure 6.) Therefore, in this embodiment, Ennio does not teach or suggest, at least, "said twisted-wire core being oriented such that said bristle-carrying portion forms an angle greater than about 0° and less than about 20° relative to said longitudinal axis of said rod," as recited in claim 1.

Accordingly, Ennio, does not teach or suggest, at least, a "twisted-wire core being oriented such that said bristle-carrying portion forms an angle greater than about 0° and less than about 20° relative to said longitudinal axis of

said rod; and a receptacle . . . having an inner wall, said rod and said brush being spaced from said inner wall in said assembled condition," as recited in claim 1.

Claims 5-11, 16-18, 29-32 and 34 depend from independent claim 1. Because claim 1 is believed to be in condition for allowance, claims 5-11, 16-18, 29-32 and 34 are also believed to be in condition for allowance, at least by reason of their dependency from claim 1. Accordingly, withdrawal of the rejection is respectfully requested.

Rejection over Ennio in view of Gueret

Claims 2-4, 12-15, 19-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ennio and further in view of Gueret (U.S. Patent No. 5,918,994).

As discussed previously, Ennio does not teach or suggest, at least, a "twisted-wire core being oriented such that said bristle-carrying portion forms an angle greater than about 0° and less than about 20° relative to said longitudinal axis of said rod; and a receptacle . . . having an inner wall, said rod and said brush being spaced from said inner wall in said assembled condition," as recited in claim 1.

Gueret does not cure the deficiencies of Ennio. Rather, Gueret is directed to mascara applicators in which the brush portion and the rod are collinear, and in which the bristle portion of the applicator is spaced from the wall of the receptacle. Nowhere does Gueret suggest, however, that the bristle portion of the applicator can be spaced from the wall of the receptacle while being oriented at an oblique angle to the rod.

Accordingly, neither Ennio nor Gueret, alone or in combination, teach or suggest, at least, a "twisted-wire core being oriented such that said bristle-carrying portion forms an

angle greater than about 0° and less than about 20° relative to said longitudinal axis of said rod; and a receptacle . . . having an inner wall, said rod and said brush being spaced from said inner wall in said assembled condition," as recited in claim 1.

Claims 2-4, 12-15 and 19-28 depend from independent claim 1. Because claim 1 is believed to be in condition for allowance, claims 2-4, 12-15 and 19-28 are also believed to be in condition for allowance, at least by reason of their dependency from claim 1. Accordingly, withdrawal of the rejection is respectfully requested.

Rejection over Gueret in view of Ennio

Claims 1-34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gueret (U.S. Patent No. 5,918,994) in view of Ennio. As stated previously Gueret does not teach or suggest, at least, a "twisted-wire core being oriented such that said bristle-carrying portion forms an angle greater than about 0° and less than about 20° relative to said longitudinal axis of said rod," as recited in claim 1.

As the Examiner admits on page 3, Gueret does not disclose the brush being at a non-zero angle to the longitudinal axis of the applicator. Although Ennio has a brush oriented at a non-zero angle such brush contacts the inner wall of the receptacle in the assembled position. Moreover, in both references, when the brush is spaced from the inner wall of the receptacle the bristle-carrying portion is collinear with the longitudinal axis of the rod. Thus, together, Gueret and Ennio do not disclose or suggest a "twisted-wire core being oriented such that said bristle-carrying portion forms an angle greater than about 0° and less than about 20° relative to said longitudinal axis of said rod; and a receptacle . . . having an

inner wall, said rod and said brush being spaced from said inner wall in said assembled condition," as recited in claim 1.

Claims 2-32 and 34 depend from independent claim 1. Because claim 1 is believed to be in condition for allowance, claims 2-32 and 34 are also believed to be in condition for allowance, at least by reason of their dependency from claim 1. Accordingly, withdrawal of the rejection is respectfully requested.

#### CONCLUSION

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he/she telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: May 10, 2007

Respectfully submitted,

By   
Rabiya S. Kader

Registration No.: 48,160  
LERNER, DAVID, LITTENBERG,  
KRUMHOLZ & MENTLIK, LLP  
600 South Avenue West  
Westfield, New Jersey 07090  
(908) 654-5000  
Attorney for Applicant